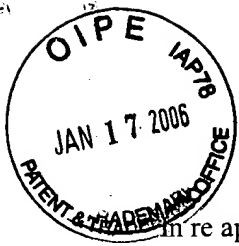


01-19-06

DAC  
JFW

# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Avi Ashkenazi, et al.

Application Serial No. 09/904,766

Filed: July 12, 2001

For: **PRO269 POLYPEPTIDES**

Examiner: Kemmerer, Elizabeth

Art Unit: 1646

Confirmation No. 4054

Attorney's Docket No. 39780-1618P2C33

Customer No. 35489

EXPRESS MAIL LABEL NO. EV765 981 111 US

DATE MAILED: January 17, 2006

## PETITION FOR DESIGNATION AS NEW GROUNDS OF REJECTION UNDER 37 C.F.R. §1.181

### MAIL STOP PETITION

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Sir:

This Application is under Appeal. An Examiner's Answer was mailed on November 15, 2005 in this case. This petition is filed:

☒ within two months of the mailing of the Examiner's Answer (January 15 and 16, 2006 being a Sunday and Federal Holiday in the District of Columbia, respectively).

The proposed Reply Brief

- ☒ has been filed separately;
- ☐ is attached;
- ☒ with a request for Oral Hearing; and
- ☒ a copy of the Petition for designation of new grounds of rejection in the Examiner's Answer under 37 CFR §1.181

The application status is:

- ☐ Small Entity—fee \$
- ☒ Large Entity—fee \$
- ☐ Enclosed is Check No. \_\_\_\_\_ in the amount of \$\_\_\_\_\_.
- ☒ The Commissioner is authorized to charge (or credit any overpayment) Deposit Account No. 08-1641 (referencing Attorney's Docket No. 39780-1618P2C33) in the amount of \$130.00 for the Petition Fee.

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### STATEMENT

An Appellants' Appeal Brief was filed on September 13, 2005 and an Examiner's Answer was mailed on November 15, 2005 in this case. Concurrent with the filing of this Petition, Applicants are filing a Reply Brief and a request for an Oral Hearing.

Appellants submit that a number of grounds of rejection set forth in the Examiner's Answer mailed on November 15, 2005 constitute new grounds of rejection. Appellants request that the grounds of rejection identified below and the six new references which are being cited in the Examiner's Answer in support of the grounds of rejection be designated new grounds of rejection. Appellants request a corrected Examiner's Answer which identifies the rejections as new grounds for rejection. Appellants further request that prosecution be reopened.

The Examiner has raised six new references for the first time in the Examiner's response. They are:

- (1) Chen *et al.*; 2002, Molecular and Cellular Proteomics 1:304-313;
- (2) LaBaer; 2003, Nature Biotechnology 21:976-977;
- (3) Gygi *et al.*; 1999, Mol. Cell. Biol. 19:1720-1730;
- (4) Lian *et al.* 2001, Blood 98:513-524;
- (5) Fessler *et al.*, 2002, J. Biol. Chem. 277:31291-31302; and
- (6) Greenbaum *et al.*, 2003, Genome Biology 4:117.1-117.8.

These references were not previously cited in any of the prior rejections of record. Appellants submit that the citation of such new prior art references for the first time in an Examiner's answer constitutes a new ground of rejection and is not permissible.

### Legal Analysis

The M.P.E.P. Section 1207.03 (III) states that:

A new prior art reference cited for the first time in an examiner's answer generally will constitute a new ground of rejection. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a new ground of rejection. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). However, where a newly cited reference is added merely as evidence of the prior well known statement made by the examiner, the citation of the reference in the examiner's answer would not constitute a new ground of rejection within the meaning of 37 CFR §1.192(a) (2). See also MPEP §2144.03.

The M.P.E.P. adds that:

In addition, if an Appellant has clearly set forth an argument in a previous reply during prosecution of the application and the Examiner has failed to address that argument, the Examiner would not be permitted to add a new ground of rejection in the Examiner's answer to respond to that argument but would be permitted to reopen prosecution, if appropriate. (Emphasis added; See M.P.E.P. §1207.03; Requirements for a new ground of rejection, II).

The Court of Customs and Patent Appeals considered this situation in *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970). In that case there were two other references cited in the appeal which were not mentioned in the statement of either of the appealed rejections. The court held:

Appellant's complaint seems to be justified, and if we did not find the rejections based *solely* on Molotsky and the French patent to be sound, we might well feel constrained to reverse the decision of the board. Where a reference is relied on to support a rejection, whether or not in a "minor capacity" there would appear to be no excuse for not positively including the reference in the statement of rejection.

Appellants note that a Reply Brief must be in compliance with the requirements set forth in 37 C.F.R. §41.41. New or non-admitted affidavits and/or other evidence are not permitted in a reply brief.

For the detailed reasons set forth below, Appellants submit that the citation for the first time of these six references constitute a new ground of rejection and accordingly such rejections are not permissible.

### **Detailed Analysis**

(1) Chen *et al.*; 2002, Molecular and Cellular Proteomics 1:304-313

The Examiner states at page 5, line 25 – page 6, line 8 of the Examiner's response that "Even if increased mRNA levels could be established for PRO269, it does not follow that polypeptide levels would also be amplified. Chen et al. (2002, Molecular and Cellular Proteomics 1:304-313) compared mRNA and protein expression for a cohort of genes in the same lung adenocarcinomas. Only 17% of 165 protein spots or 21% of the genes had a significant correlation between protein and mRNA expression levels. Chen et al. clearly state that 'the use of mRNA expression patterns by themselves, however, is insufficient for understanding the expression of protein products'(p.304) and 'it is not possible to predict overall protein expression levels based on average mRNA abundance in lung cancer samples' (pp.311-312)"

The Examiner makes reference to specific experimental details and statistical percentages present in the Chen reference for the first time. This constitutes a new ground of rejection.

The Examiner cites Chen throughout the Examiner's Answer, for example, in support of rejections at page 10, lines 10-14; page 11, lines 13-16; page 14, lines 12 -21; page 17, lines 19-22; page 18, line 19 – page 19, line 2; page 19, lines 12-14; page 20, lines 13 - 15; page 27, lines 4 - 12; page 28, lines 8-12; page 29, lines 17-20; page 31, lines 15-21; page 33, lines 11-16; page 35, lines 13-21; and page 40, lines 18-22.

Appellants submit that they are unable to adequately rebut the Chen reference and each of the rejections based on Chen without presenting substantive evidence of their own. The M.P.E.P. and the case law clearly state that the Examiner is not allowed to make new grounds of rejection and cite a new reference, Chen. Furthermore, it is inequitable to allow the Examiner to do so without allowing Appellants to present evidence in rebuttal. Appellants submit that the citation of Chen and raising of the grounds of rejection based on Chen constitute new grounds of rejection.

(2) LaBaer; 2003, Nature Biotechnology 21:976-977

The Examiner cites LaBaer for the first time on page 6, lines 16 - 20; where she states that:

“One of the authors of this paper, Dr. LaBaer made an even stronger statement that reports of mRNA or protein changes of as little as two fold are not uncommon, and although changes of this magnitude may turn out to be important, most are attributable to disease-independent differences between the samples.”

The Examiner cites LaBaer throughout the Examiner's Answer, for example, in support of rejections at page 10, lines 10-14; page 11, lines 13-16; page 15, lines 7-11; page 17, lines 19-22; page 18, line 19 – page 19, line 2; page 19, lines 12-14; page 20, lines 18-22; page 27, lines 4 - 12; page 29, lines 17-20; page 33, lines 11-16; page 36, lines 7 – 11 and page 40, lines 18-22.

In this case, the Examiner's basis for rejection that differences of as little as two fold are not uncommon and that changes of this magnitude relate to disease-independent differences between the samples” is being made for the first time.

Appellants submit that they are unable to adequately rebut the LaBaer reference and each of the rejections based on LaBaer without presenting substantive evidence of their own. The M.P.E.P. and the case law clearly state that the Examiner is not allowed to make new grounds of rejection and cite a new reference, LaBaer. Furthermore, it is inequitable to allow the Examiner to do so without allowing Appellants to present evidence in rebuttal. Appellants submit that the citation of LaBaer and raising of the grounds of rejection based on LaBaer constitute new grounds of rejection.

- (3) Gygi *et al.*; 1999, Mol. Cell. Biol. 19:1720-1730;
- (4) Lian *et al.* 2001, Blood 98:513-524; and
- (5) Fessler *et al.*, 2002, J. Biol. Chem. 277:31291-31302..

Similarly, regarding (3) Gygi, (4) Lian, and (5) Fessler, the Examiner cites these references for the first time in the Examiner's Answer on page 7. The Examiner states that Gygi *et al.* "conducted a similar study with over 150 polypeptides," Lian *et al.* "show a similar lack of correlation in mammalian (mouse) cells," and Fessler *et al.* "found a '[p]oor concordance between mRNA transcript and protein expression changes' in human cells". These references are presented for the first time and hence, each constitutes a new ground of rejection.

These references are further cited throughout the Examiner's Answer in support of various rejections, for example, at page 10, lines 10-14; page 11, lines 13-16; page 15, line 19 – page 16, line 14; page 17, lines 19-22; page 18, line 19 – page 19, line 2; page 19, lines 12-14; page 20, line 22 – page 21, line 5; page 27, lines 4 - 12; page 28, lines 8 – 12; page 29, lines 17-20; page 33, lines 11-16; page 36, line 19 – page 37, line 5 and page 40, lines 18-22.

Appellants submit that they are unable to adequately rebut these references and each of the rejections based on these references without presenting substantive evidence of their own. The M.P.E.P. and the case law clearly state that the Examiner is not allowed to make new grounds of rejection and cite a new reference. Furthermore, it is inequitable to allow the Examiner to do so without allowing Appellants to present evidence in rebuttal. Appellants submit that the citation of these references and raising of the grounds of rejection based on these references constitute new grounds of rejection. Appellants further request that prosecution be reopened.

- (6) Greenbaum *et al.*, 2003, Genome Biology 4:117.1-117.8.

Similarly, regarding (6) Greenbaum *et al.*, the Examiner cites this reference for the first time in the Examiner's Answer on pages 7 through 8. The Examiner states that Greenbaum *et al.*

"cautions against assuming that mRNA levels are generally correlative of protein levels. The reference teaches (p-age 117.3 2<sup>nd</sup> column) that primarily because of a limited ability to measure protein abundances, researchers have tried to find correlations between mRNA and the limited protein expression data, in the hope that they could determine protein abundance levels from the more copious and technically easier mRNA experiments. To date, however, there have been only a handful of efforts to find correlations between mRNA and protein expression levels, most notably in human cancers and yeast cells. And, for the most part, they have reported only minimal and/or limited correlations. The reference further teaches (page 117.4, 2<sup>nd</sup> column) that there are presumably at least three reasons for the poor correlations generally reported in the literature between the level of mRNA and the level pf protein, and these may not be mutually exclusive. First, there are many complicated

and varied post-transcriptional mechanisms involved in turning mRNA into protein that are not yet sufficiently well defined to be able to compute protein concentrations from mRNA; second, proteins may differ substantially in their *in vivo* half lives; and/or third, there is a significant amount of error and noise in both protein and mRNA experiments that limit our ability to get a clear picture. The reference further notes (page 117.6, page 2<sup>nd</sup> column) that to be fully able to understand the relationship between mRNA and protein abundances, the dynamic processes involved in protein synthesis and degradation have to be better understood.”

This reference and each of these arguments are presented for the first time and hence, each constitutes a new ground of rejection.

This reference is further cited throughout the Examiner's Answer in support of various rejections, for example, at page 10, lines 10-14; page 11, lines 13-16; page 16, line 14 – page 17, line 8; page 17, lines 19-22; page 18, line 19 – page 19, line 2; page 19, lines 12-14; page 21, lines 5-9; page 27, lines 4 - 12; page 28, lines 8 – 12; page 33, lines 11-16; page 37, line 7 19 – page 38, line 2 and page 40, lines 18-22.

Appellants submit that they are unable to adequately rebut this reference and each of the rejections based on this reference without presenting substantive evidence of their own. The M.P.E.P. and the case law clearly state that the Examiner is not allowed to make new grounds of rejection and cite a new reference. Furthermore, it is inequitable to allow the Examiner to do so without allowing Appellants to present evidence in rebuttal. Appellants submit that the citation of these references and raising of the grounds of rejection based on these references constitute new grounds of rejection. Appellants further request that prosecution be reopened.

Appellants submit that this issue of the new grounds of rejections is being timely raised by the filing of this petition under 37 C.F.R. §1.181 with necessary fees and concurrently, with the filing of a Reply Brief within the two month period set for the Appellants' response.

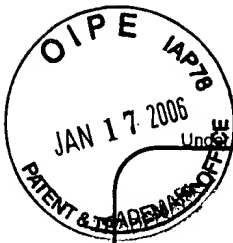
Respectfully submitted,

Date: January 17, 2006

By: Leslie Mooi  
Leslie A. Mooi (Reg. No. 37,047)

**HELLER EHRMAN LLP**  
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1/17/06 12:57 PM (39780.1618)



PTO/SB/21 (09-04)

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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	09/904,766
Filing Date	July 12, 2001
First Named Inventor	Avi Ashkenazi
Art Unit	1646
Examiner Name	Kemmerer, Elizabeth
Attorney Docket Number	39780-1618P1C33

**ENCLOSURES (Check all that apply)**

- |   |  |  |
|---|--|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/<br>Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts<br>under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a<br>Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address<br><br><input type="checkbox"/> Terminal Disclaimer<br><br><input type="checkbox"/> Request for Refund<br><br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC<br><br><input type="checkbox"/> Appeal Communication to Board<br>of Appeals and Interferences<br><br><input type="checkbox"/> Appeal Communication to TC<br>(Appeal Notice, Brief, Reply Brief)<br><br><input type="checkbox"/> Proprietary Information<br><br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify<br>below):<br>Petition for Designation As New Grounds of<br>Rejection Under 37 CFR 1.181; return<br>postcard |
|---|--|--|

Remarks

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	HELLER EHRMAN LLP		
Signature			
Printed name	Leslie Mooi		
Date	January 17, 2006	Reg. No.	37,047

**CERTIFICATE OF TRANSMISSION/MAILING**

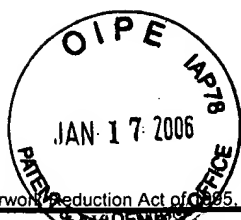
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Signature

Typed or printed name	Rachel Mena	Date	January 17, 2006
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This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

# FEE TRANSMITTAL for FY 2006

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 130

## Complete if Known

Application Number	09/904,766
Filing Date	July 12, 2001
First Named Inventor	Avi Ashkenazi
Examiner Name	Kemmerer, Elizabeth
Art Unit	1646
Attorney Docket No.	39780-1618P2C33

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit  
Account  
Number  
Deposit  
Account  
Name

08-1641

HELLER EHRMAN LLP (39780-1618P2C33)

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	300	2001	150	Utility filing fee	
1002	200	2002	100	Design filing fee	
1003	200	2003	100	Plant filing fee	
1004	300	2004	150	Reissue filing fee	
1005	200	2005	100	Provisional filing fee	
SUBTOTAL (1)				(\$ )	0

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below		Fee Paid
Total Claims		-20** =		X		
Independent Claims		-3** =		X		
Multiple Dependent						

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	50	2202	25	Claims in excess of 20
1201	200	2201	100	Independent claims in excess of 3
1203	360	2203	180	Multiple dependent claim, if not paid
1204	200	2204	100	** Reissue independent claims over original patent
1205	50	2205	25	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ ) 0

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1,020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1,080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	
1403	1,000	2403	500	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	500	2452	250	Petition to revive - unavoidable	
1453	1,500	2453	750	Petition to revive - unintentional	
1501	1,400	2501	700	Utility issue fee (or reissue)	
1502	800	2502	400	Design issue fee	
1503	1,100	2503	550	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	130
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ ) 130.00

## SUBMITTED BY

Name (Print/Type)

Leslie Mooi

Registration No.  
(Attorney/Agent)

37,047

(Complete (if applicable))

Telephone (650) 324-7000

Signature

*Leslie Mooi*

Date

JANUARY 17, 2006

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